

CONF  
A 2

15. A method for controlling termites, which comprises applying to the locus where control is desired a pesticidally-effective amount of the composition of claim 14.

16. A pesticidal composition for the control of termites comprising, in admixture with a pesticidally acceptable carrier, benzyl alcohol,  $\alpha$ -terpineol, phenyl ethyl propionate, and phenyl ethyl alcohol.

17. A method for controlling termites, which comprises applying to the locus where control is desired a pesticidally-effective amount of the composition of claim 16.

18. A pesticidal composition for the control of termites comprising, in admixture with a pesticidally acceptable carrier, eugenol,  $\alpha$ -terpineol and cinnamic alcohol.

19. A method for controlling termites, which comprises applying to the locus where control is desired a pesticidally-effective amount of the composition of claim 18.

### REMARKS

Claims 1 through 3 and 7 through 19 are pending. Claims 4 through 6 are withdrawn as being directed to non-elected subject matter. Claims 2 and 3 are canceled, without prejudice to, or disclaimer of, the subject matter they contain. Claim 1 is amended and Claims 8 through 19 are added to encompass infringing subject matter. No new matter is introduced into the patent application.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made."

**The Restriction/Election Requirement**

Applicant acknowledges that he has provisionally and orally elected with traverse Group I (Claims 1, 2, 3, and 7) and the plant essential oil species of benzyl alcohol for initial prosecution on the merits. On September 24, 2001 Applicant submitted to the Patent Office a written Confirmation of Telephone Election traversing on the grounds that no reasons for the restriction and election of species requirements exist on the written record.

Now, in response to the written Election/Restriction Applicant submits that a restriction requirement between patentably distinct inventions is proper only when there is a serious burden on the Patent Office to examine all of the claims in a single application even when it appears that appropriate reasons exist for a restriction requirement. M.P.E.P. § 803. To avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office, Applicant respectfully requests that the above policy be applied in the present application because the subject matter of the pending claims is sufficiently related.

For instance, Group I is directed to contact pesticidal compositions comprising plant essential oil compounds admixed with a carrier, and a method for controlling pests with such composition. Group II is directed to a fumigant pesticidal compositions comprising plant essential oil compounds admixed with carrier. Applicants respectfully submit that a search for the invention(s) of either of Groups I or Group II would necessarily overlap with each other. Group I and II both comprise the same pesticidal compositions. The distinguishing feature between the two groups is the carrier, in which a fumigant might vary from a contact pesticide. Thus, a thorough search for subject matter of any one claims of the above-captioned patent application would overlap with a search for the subject matter of the remaining claims such that a search and examination of the entire application can be made without serious burden.

**The Rejections Under 35 U.S.C. §112**

Claims 1 through 3 and 7 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states as follows.

"Derivative" is indefinite--is carbon dioxide or water intended?

"Acceptable" is indefinite- to whom? How?

Parentheses should not be used in claims. What are V-compounds--if trade names, please identify generically; actually, structurally, and provide RN, CAS numbers.

Office Action at page 4. Applicant traverses these rejections to the extent they may be applicable to the claims as amended.

Solely in an effort to expedite prosecution, Applicant has deleted "or derivative thereof" from Claim 1 and Claim 2 has been canceled to obviate any ambiguity.

Likewise, in Claim 1 Applicant has replaced "acceptable" with "pesticidally acceptable" to obviate any ambiguity in the type of carrier.

Also, Applicant has deleted all use of parentheses in the language of the claims.

To obviate any ambiguity "V-1924 and V-3052" have been deleted from the markush group of amended Claim 1 which now recites and identifies by name the individual compounds that make up the "V-compounds."

As a result, Applicants respectfully submit that the claims clearly delineate the metes and bounds of the invention and therefore the claims as recited are not indefinite and respectfully request reconsideration and withdrawal of these rejections.

**The Rejections Under 35 U.S.C. §102(b)**

Claims 1 through 3 and 7 stand rejected under 35 U.S.C. §1-2(b) as assertedly being anticipated by Pallaske et al. DE 4231045, Jumo--JP 10203918 Abstract, Sugiura et al. JP 08119819, Lin et al, Sharma et al and Dow et al. In addition, Claims 1 through 3 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Yang--4446153. The Office Action States as follows.

Pallaske: See Fig. The instant essential oils are pesticidally effective, unacceptable carriers (col. 3).

Lin: See abstract: carriers include (p.461) silica, Eugenol and (abstract) the essential oils of Cinnamomum leaves--as actives, eugenol, cinnamaldehyde.

Jumo: derivatives of the instant essential oils with aqueous surfactant carrier control termites.

Sugiura: essential oils acceptable carriers, contain the instant derivatives and are pesticidal to termites.

Sharma: Terpenoids and essential oils are effective for termite control (Table 2), and can be incorporated in acceptable carriers to be placed at the locus of the desired control (last paragraph).

Dow: Acceptable vehicles for benzyl alcohol are shown (col. 1, last paragraph, col. 2, top page 1). It is applied to the locus where protection is desired--(col. 1, lines 25-33) happens to be trees, inherently protection from tree eaters, termites, would occur, as they are insects.

Yang: See claims: acceptable carrier and benzyl. Alcohol: claim 1, if present, termites inherently would be controlled.

Office Action at pages 4 and 5.

Applicant respectfully traverses the above-mentioned rejections for at least the following reasons.

The initial burden of establishing a prima facie basis to deny patentability to a claimed invention under any statutory provision always rests on the Patent Office. *In re Mayne*, 104 F.3d 1339, 41 U.S.P.Q.2d 1451 (Fed. Cir. 1997); *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). Applicants respectfully submit that the Office Action has not discharged this initial burden. The factual determination of lack of novelty under 35 U.S.C. §102 requires the

identical disclosure in a single reference of each element of a claimed invention. *The Kegel Co. v. AMF Bowling*, 127 F.3d 1420, 44 USPQ2d 1123 (Fed. Cir. 1997); *Gechter v. Davidson*, 116 F.3d 1454, 43 USPQ2d 1030 (Fed. Cir. 1997). In rejecting a claim under 35 U.S.C. §102, the PTO is required to identify wherein a particular reference identically discloses each feature of the claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). There are significant differences between the presently claimed invention and the cited references.

Pallaske et al. neither anticipates nor teaches Applicant's invention. At best, Pallaske et al. discloses compositions against termites comprising eugenol, thymol,  $\alpha$ -piriene, and berneol. Pallaske et al., however, fails to expressly or specifically disclose each and every element of the claimed invention. Pallaske et al. does not disclose, as Applicant's invention presently recited in the claims, toxic activity against cockroaches and ants. Thus, Applicants submit that the amended claims further distinguish the claimed invention from the cited reference.

Jumo-N does neither anticipates nor teaches Applicant's invention as presently recited in the claims. Jumo-N merely discloses an anti-termite wood preservative composition comprising terpinolene,  $\alpha$ -terpineol and/or terpinil acetate and oil from Hiba wood. Jumo-N, however, fails to expressly or specifically disclose the each feature of the claimed invention. Jumo-N does not disclose Applicant's claimed pesticidal composition for controlling termites and the methods thereof. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Sugiura et al. does not disclose and therefore does not anticipate Applicant's claimed invention. Sugiura et al. merely discloses an insect repellent against the ant, *Pristomyrmex pungens*, containing cassia oil, pimenta oil, bay oil, cinnamon oil, cedarwood oil and pine oil.

Not one of the natural oils disclosed in Sugiura et al. comprises the claimed invention. As a result, Sugiura et al. does not anticipate the claimed invention. Accordingly, the rejection over Sugiura et al. should be reconsidered and withdrawn and such favorable action is respectfully requested.

Similarly, neither Lin et al. nor Sharma et al. disclose or teach Applicant's invention as presently recited in the claims. At best, Lin et al. discloses the natural oils of *Cinnamomum osmophloeum* Kaneh and *C. zeqlanicum* B1 having termite resistance. Sharma et al. merely discloses several terpenoids and oils having vapor toxicity and repellency against the termite, *Odontotermes brunneus*. Neither Lin et al. nor Sharma et al. expressly or specifically disclose Applicant's claimed pesticidal composition for controlling termites and the methods thereof as recited in the claims. Thus, neither Lin et al. nor Sharma et al. anticipate Applicant's invention and reconsideration and withdrawal of these rejections are respectfully requested.

Lastly, Dow et al. and Yang, also, do not disclose Applicant's invention as presently recited in the claims. Dow et al. merely discloses halohydrin or chlorohydrin as a suitable carrier for benzyl alcohol to control aphids and similar sucking insects and the red spider. At best, Yang discloses benzyl alcohol and phenethyl alcohol as a sanitizing and microbiocidal agent for the bovine teats and udder. Neither Dow et al. nor Yang expressly or specifically disclose Applicant's claimed compositions and methods for controlling termites.

Moreover, to whatever extent the imposed rejections are predicated upon the doctrine of inherency, such reliance is totally misplaced. As mentioned, Dow et al. merely relates to an insecticide against aphids and the red spider, and Yang only relates to an anti-microbial composition for sanitizing bovine teats and udders. Neither of these references disclose pesticidal compositions against termites. Indeed, this reference is conspicuously mute to the

fundamental concept of Applicants' invention for controlling termites. This fundamental difference alone between the claimed invention and WO 98/30124 is sufficient to undermine the factual determination of lack of novelty under 35 U.S.C. §102. *See Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Furthermore, it is well settled that the doctrine of inherency requires both certainty and art recognition. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 167 (Fed. Cir. 1994); *Electro Medical Systems S.A. v. Cooper, Life Sciences, Inc.* 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Probabilities or possibilities are not sufficient to establish inherency. *In re Oelrich*, 666 F.2d 578, 581-82 (Fed. Cir. 1993). Both Dow et al. and Yang fail to satisfy the requirement for certainty coupled with art recognition. It is not apparent, and the PTO has not identified, wherein these cited references lies a disclosure of the activity of the presently claimed compositions. In fact, the PTO specifically sets forth in the Office Action its presumption that compositions effective against aphids, red spiders and microbes translates to all species merely due to the presence of benzyl alcohol or phenethyl alcohol. There is no basis upon which to predicate the determination that the use of rosemary oil in accordance with the teachings of Dow et al. and Yang necessarily involve the control of termites. Accordingly, there is no basis upon which to invoke the doctrine of inherency. Thus, reconsideration and withdrawal of these rejections are respectfully requested.

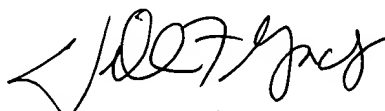
## **CONCLUSION**

Early consideration and prompt allowance of the pending claims are respectfully requested. If anything could be done to place this application in condition for allowance, e.g., by

Examiner's Amendment, Applicants respectfully request that the Examiner contact the undersigned representative at the telephone number listed below.

To the extent necessary, please grant any extension of time deemed necessary for entry of this communication. Please charge any deficient fees, or credit any overpayment of fees, to Deposit Account 500417.

Respectfully submitted,

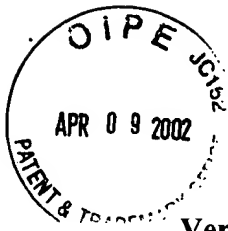
A handwritten signature in black ink, appearing to read 'W. F. Gadiano', with a stylized flourish at the end.

Willem F. Gadiano  
Registration No. 37,136

**DATE: April 9, 2002**

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## ATTACHMENT

### Version With Markings To Show Changes Made

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### IN THE CLAIMS

1. [Amended] A contact pesticidal composition for the control of termites comprising, in admixture with a[n] pesticidally acceptable carrier, at least one plant essential oil compound[ or derivative thereof] selected from a group consisting of pure aldehyde C16, amyl cinnamic aldehyde, amyl salicylate, anisic aldehyde, benzyl alcohol, benzyl acetate, cinnamaldehyde, cinnamic alcohol, carvacrol, carveol, citral, cineole, citronellol, p-cymene, diethyl phthalate, dimethyl salicylate, dipropylene glycol, eucalyptol, iso-eugenol, galaxolide, guaiacol, ionone, menthol, methyl anthranilate, methyl ionone, methyl salicylate,  $\alpha$ -phellandrene, pennyroyal oil, perillaldehyde, 1- or 2-phenyl ethyl alcohol, 1- or 2-phenyl ethyl propionate, piperonal, piperonyl acetate, piperonyl alcohol, D-pulegone, terpinen-4-ol, 4-tert butylcyclohexyl acetate, thyme oil, trans-anethole, metabolites of trans-anethole, vanillin, ethyl vanillin.

2. [CANCELED]
3. [CANCELED]
4. [WITHDRAWN]
5. [WITHDRAWN]
6. [WITHDRAWN]

**Claims 8 through 19 have been added as follows.**

8. [New] A pesticidal composition for the control of termites comprising benzyl acetate in admixture with a pesticidally acceptable carrier.
9. [New] A method for controlling termites, which comprises applying to the locus where control is desired a pesticidally-effective amount of the composition of claim 8.
10. [New] A pesticidal composition for the control of termites comprising phenyl ethyl propionate in admixture with a pesticidally acceptable carrier.
11. [New] A method for controlling termites, which comprises applying to the locus where control is desired a pesticidally-effective amount of the composition of claim 10.
12. [New] A pesticidal composition for the control of termites comprising benzyl alcohol in admixture with a pesticidally acceptable carrier.
13. [New] A method for controlling termites, which comprises applying to the locus where control is desired a pesticidally-effective amount of the composition of claim 12.
14. [New] A pesticidal composition for the control of termites comprising trans-anethole in admixture with a pesticidally acceptable carrier.
15. [New] A method for controlling termites, which comprises applying to the locus where control is desired a pesticidally-effective amount of the composition of claim 14.
16. [New] A pesticidal composition for the control of termites comprising, in admixture with a pesticidally acceptable carrier, benzyl alcohol,  $\alpha$ -terpineol, phenyl ethyl propionate, and phenyl ethyl alcohol.
17. [New] A method for controlling termites, which comprises applying to the locus where control is desired a pesticidally-effective amount of the composition of claim 16.
18. [New] A pesticidal composition for the control of termites comprising, in admixture with a pesticidally acceptable carrier, eugenol,  $\alpha$ -terpineol and cinnamic alcohol.

19. [New] A method for controlling termites, which comprises applying to the locus where control is desired a pesticidally-effective amount of the composition of claim 18.